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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,972	03/11/2004	Masaya Yamamoto	2004_0392A	4039
513 7590 10/16/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
SAN JUAN, MARTINERIKO P				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/796,972

**Applicant(s)**

YAMAMOTO ET AL.

**Examiner**

MARTIN JERIKO P. SAN JUAN

**Art Unit**

2432

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-41 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 19-41 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is a response to a Request for Continued Examination filed September 15, 2008.

Claims 19-41 are currently pending.

#### ***Response to Arguments***

1. Applicant's arguments, see Remarks and Amendments, filed September 15, 2008, with respect to the rejection(s) of claim(s) 19-37 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Sims III.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 19-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Sims III [US 2002/0016919 A1].

Regarding claim 28, Sims III teaches a content playback method used in a playback terminal for playing back content, the content playback method comprising: reading encrypted content from a portable medium [Sims III 9: 0097 --Encrypted disk key is provided to the play-back device decoder to allow meaningful use of the content recorded thereon.]; judging whether or not information managed by an external license server is required for decrypting the encrypted content [Sims III 9: 0098]; reading medium information pre-recorded on the portable medium [Sims III 8: 0091]; acquiring

the information managed by the external license server when it is judged that the information is required [Sims III 9: 0098]; and a decryption step of (a) decrypting the encrypted content using only the medium information and information pre-stored in the playback terminal itself, without using information managed by the external license server, when it is judged that information is not required, [Sims III 8: 0091] [Sims III 9: 0097] and (b) decrypting the encrypted content using the information acquired from the external license server when it is judged that the information is required [Sims III 10: 0106].

Regarding claim 41, Sims III teaches the content playback method of claim 28, wherein the information managed by the external license server is rights information including usage rights for the content [Sims III 9: 0100 –rights information is associated with determination of single use or unlimited use by external source.], the judging comprises judging whether or not the rights information is required, as the information managed by the external license server, for decrypting the encrypted content [Sims III 9: 0098], the acquiring comprises acquiring the rights information from the external license server when it is judged that the rights information is required [Sims III 9: 100-101 --acquiring the requested information associated with single use or unlimited use], and the decryption step comprises (a) decrypting the encrypted content using only the medium information and the information pre-stored in the playback terminal itself, without using the rights information, when it is judged that the rights information is not required [Sims III 8: 0091] [Sims III 9: 0097], and (b) decrypting the encrypted content using the rights information when it is judged that the rights information is required [Sims III 10: 0106].

Regarding claim 29, Sims III teaches the content playback method of claim 41, wherein the medium information includes a media key [Sims III 7: 0071 --Disk Key], and the decryption step includes: a content key obtaining sub-step of, when it is judged that the rights information is not required, obtaining the media key from the medium information and, using the obtained media key, obtaining a first content key used in decrypting of the encrypted content [Sims III 9: 0097 --Use Disk key as Content key]; and a content decryption sub-step of, when it is judged that the rights information is not required, decrypting the encrypted content using the first content key [Sims 6: 0057].

Regarding claim 30, Sims III teaches the content playback method claim 29, wherein the content key obtaining sub-step includes, when it is judged that the rights information is required, obtaining a second content key used in decrypting of the encrypted content [Sims 10: 0106 --content key], using the rights information [Sims 10: 0106 --random number, as this is associated with usage or rights information], and the content decryption sub-step includes, when it is judged that the rights information is required, decrypting the encrypted content using the second content key [Sims 10: 0107].

Regarding claim 31, Sims III teaches the content playback method of claim 30, wherein the rights information includes a rights key [Sims 10: 0106 --random number], and the content key obtaining sub-step includes, when it is judged that the rights information is required, obtaining the second content key using the rights key [Sims 10: 0106 -- content key XOR random number by clearinghouse for provisioning].

Regarding claim 32, Sims III teaches the content playback method of claim 31, wherein the content key obtaining sub-step includes, when it is judged that the rights information

is required, obtaining the second content key using both the rights key and the media key [Sims 6: 0057] [Sims 10: 0103 –Encrypted Disk Key provided to Clearing house.]. Regarding claim 33, Sims III teaches the content playback method of claim 30, wherein the portable medium further has stored thereon key obtaining information indicating whether or not the rights information is required for obtaining a key used for decrypting the encrypted content [Sims 8: 0086-0088], and the content playback method further comprises: reading the key obtaining information from the portable medium [Sims 8: 0091] [Sims 9: 0102], wherein the judging comprises judging whether or not the rights information is required for decrypting the encrypted content, based on the key obtaining information [Sims 9: 0098].

Regarding claim 34, Sims III teaches the content playback method of claim 29, wherein the decryption step includes, when it is judged that the rights information is necessary, performing decryption of the encrypted content [Sims 10: 0107] only when the acquiring has already acquired the rights information and the rights information indicates that usage of the content is permitted [Sims 9-10: 0100-0104].

Regarding claim 35, Sims III teaches the content playback method of claim 29, wherein the playback terminal includes a holding unit operable to hold device unique information that is unique to the playback terminal [Sims 4: 0036-0037], the media key is in an encrypted state [Sims 9: 0097 --encrypted Disk Key], having been encrypted using the device unique information [Sims 9: 0097 –encrypted with the public key of the matching “acceptable user”], and the content key obtaining sub-step includes, when it is judged that the rights information is not required, obtaining the media key by decrypting the

encrypted-state media key using the device unique information [Sims 9: 0097 -- decrypted with the private key of the matching "acceptable user."].

Regarding claim 36, Sims III teaches the content playback method of claim 29, wherein the portable medium further has stored thereon information indicating whether or not the rights information is required for decrypting of the encrypted content [Sims 8: 0086-0088], and the content playback method further comprises: reading the information from the portable medium [Sims 8: 0091] [Sims 9: 0102], wherein the judging comprises judging whether or not the rights information is required for decrypting the encrypted content, based on the information [Sims 9: 0098].

Claims 19-27 are rejected because it is similar matter to claims 28-36.

Claim 38 is rejected because it is similar matter to claim 41.

Regarding claim 39, Sims III teaches the playback terminal of claim 20, wherein the rights information includes information showing permission to play back the content [Sims 6: 0057, 0065; 9: 0100 --authorization information is a permission information].

Regarding claim 40, Sims III teaches the playback terminal of claim 39, wherein the portable medium further has recorded thereon information indicating whether or not the rights information is necessary for decrypting the encrypted content [Sims 6: 0057-0066], and the decryption method judgment unit judges whether or not the rights information is required for decrypting the encrypted content based on the information recorded on the portable medium [Sims 8: 0091; 9: 0098; 9: 0102].

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARTIN JERIKO P. SAN JUAN whose telephone number is (571)272-7875. The examiner can normally be reached on M-F 8:30a - 6:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MJSJ/  
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